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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,367	05/04/2001	Shigeo Yanai	TESJ.0030	6795

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EXAMINER

SOTOMAYOR, JOHN

ART UNIT

PAPER NUMBER

3714

12

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,367

Applicant(s)

YANAI ET AL.

Examiner

John L Sotomayor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 13, 2004 has been entered.

In response to the amendment filed February 13, 2004, claim 1 is cancelled and claims 2-32 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 32 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In the instant case, the claim recites in the preamble that it is directed to "instructional software". Software not embodied on a computer readable medium is non-statutory and, therefore, the claim is rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 3-5,7,8 and 17-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Mengoli (US 6,514,081) in view of Ishida (US 6,514,080).

Regarding claims 30, 31 and 32, Mengoli discloses a system and method of instruction for a sport that displays a plurality of basic examples of problem points and a particular problem point as clicked on by a user (Fig 3 and 4), providing an electronic means for recording, editing and searching one improved performance image of an instructor corresponding to the clicked problem point and displaying the improved performance image of an instructor (Col 4, lines 27-58), the display containing at least one method for overcoming the clicked problem and presented in a diagrammatic representation (Col 6, lines 35-67) wherein the clicked problem point is a concrete problem of the learner in the sport (Col 5, lines 30-48) as shown by reference

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cues superimposed on the diagrammatic display. Mengoli does not specifically disclose a system and method of instruction for a sport improvement activity wherein an on demand question form is displayed and entries are analyzed so as to determine the concrete problem of the user.

However, Ishida teaches an Instructor led athletic activity training system in which a question form in the form of an on demand web page is displayed and entries are analyzed so as to determine the concrete problem of the user and the result is analyzed to determine if the skill level of the user reaches a definite standard and provides for repetition of the question form if the standard is not met (Col 4, lines 56-67 and Fig 6). Therefore it would have been obvious to one of ordinary skill in the art to provide a system and method of instruction for a sport that displays a plurality of basic examples of problem points and a particular problem point as clicked on by a user, providing an electronic means for recording, editing and searching one improved performance image of an instructor corresponding to the clicked problem point and displaying the improved performance image of an instructor, the display containing at least one method for overcoming the clicked problem and presented in a diagrammatic representation wherein the clicked problem point is a concrete problem of the learner in the sport as shown by reference cues superimposed on the diagrammatic display as disclosed by Mengoli with a system and method of instruction wherein an on demand question form is displayed and entries are analyzed so as to determine the concrete problem of the user as taught by Ishida for the purposes of optimizing the educational training in a sporting activity during the practice of the instant sport.

Regarding claim 3, Mengoli does not specifically disclose a system and method of instruction for a sport improvement activity wherein the system uses the Internet. However, Ishida teaches utilizing the Internet as means of recording, editing, processing through operations

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and searching the data for methods for improvement as recorded on images (Col 3, lines 35-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a system and method of instruction for a sport improvement activity as disclosed by Mengoli with a means to use the Internet as means of recording, editing, processing through operations and searching the data for methods for improvement as recorded on images as disclosed by Ishida for the purposes of expanding the use of the system to a wider base of users.

Regarding claim 4, Mengoli discloses a system and method of instruction for a sport utilizing a computer system for recording, editing, processing through operations and searching the data of examples of individual problem points and means of improvement (Col 3, lines 40-62).

Regarding claims 5 and 8, Mengoli discloses a system and method of instruction for a sport improvement activity comprising a set of overlapping cue lines on the performance image corresponding to the clicked problem point and the improved performance image of an instructor as criteria for improvement (Col 6, lines 20-50).

Regarding claim 7, Mengoli discloses a system and method of instruction for a sport improvement activity comprising a set of overlapping cue lines on the performance image corresponding to the clicked problem point and the improved performance image of an instructor as criteria for improvement (Col 6, lines 20-50).

Regarding claim 17, Mengoli discloses a system and method of instruction for a sport improvement activity wherein the clicked problem point and the improved performance image of an instructor are still images or moving images (Col 6, lines 28-32).

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Regarding claim 18, Mengoli discloses a system and method of instruction for a sport improvement activity wherein the performance image of the clicked problem point, the improved performance image of an instructor (Col 6, lines 20-50) and an improvement method for overcoming the clicked problem point are recorded on a recording medium (Col 8, lines 41-67).

Regarding claim 19, Mengoli discloses a system and method of instruction for a sport improvement activity wherein the sport is golf.

Claims 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mengoli. Mengoli discloses a method of instruction for a sport improvement activity wherein the sport is a team sport including baseball, soccer or basketball (claim 20), wherein the sport is a combative sport including sumo, wrestling, judo or boxing (claim 21), wherein the sport is an outdoor sport including surfing, skiing, skating or swimming (claim 22), wherein the sport involves pursuing an object including fishing or hunting (claim 23), an instructional method wherein the hobby is go, chess, shogi, dance or billiards (claim 24) or wherein the instructional method is medical treatment, a beauty treatment, weight training, flower arrangement, floral art or cooking (claim 25). Mengoli discloses an instructional method that is appropriate for activities such as baseball, tennis, dance and any other activity which includes a mechanical movement (Col 3, lines 27-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a method of instruction in a plurality of sports or activities such as baseball, wrestling, surfing, fishing or games such as billiards, flower arrangement or an activity such as cooking to provide the best example for a learner to emulate.

Regarding claims 26-29, Mengoli discloses a system and method of instruction for a sport improvement activity wherein the performance image is the most closely approximate image to

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the concrete problem of the learner stored in memory (claim 26), preparing and displaying several examples of performance problems of the learner (claim 27), the step of taking a performance image of the learner corresponding to the clicked problem point (claim 28) and wherein the concrete problem of the learner is determined by the learner (claim 29) (columns 5 and 6).

5. Claims 9, 11-13, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mengoli in view of Ishida in further view of Macri et al (US 6,183,259).

Regarding claim 9, 11-13 and 15-16, Mengoli/Ishida does not specifically disclose a system and method of instruction for a sport improvement activity wherein the performance images corresponding to the clicked problem points of an instructor are display without overlap. However, Macri et al teaches that methods for improvement may be displayed to the user in images on a single screen without overlap, comparing and contrasting differences for the education of the user (Col 5, lines 23-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a system and method of instruction for a sport improvement activity as disclosed by Mengoli/Ishida with display methods for improvement to the user in images on a single screen without overlap for the purposes of a side-by-side comparison of the user against the instructor as taught by Macri in order to assist the user in visualizing the motion needed for correction.

6. Claims 2, 6, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mengoli in view of Ishida in further view of Studor et al (US 6,152,856).

Regarding claim 2, Mengoli/Ishida does not specifically disclose using a DVD as the electronic means for recording, editing and processing through operations on video images

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selected. However, Studor et al teaches that a DVD system may be used to store and display higher quality video images (Col 6, lines 55-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a system and method of instruction for a sport improvement activity as disclosed by Mengoli/Ishida with the means to utilize a DVD for recording, editing, processing through operations and searching data for methods of improvement as recorded on images as taught by Studor et al for the purposes of providing a higher quality and longer lasting record for use in improving the skill of the user.

Regarding claim 6, Mengoli discloses a system and method of instruction for a sport improvement activity comprising a set of overlapping cue lines on the performance image corresponding to the clicked problem point and the improved performance image of an instructor as criteria for improvement (Col 6, lines 20-50).

Regarding claims 10 and 14, Mengoli/Ishida does not specifically disclose a system and method of instruction for a sport improvement activity wherein the performance images corresponding to the clicked problem points of an instructor are display without overlap. However, Macri et al teaches that methods for improvement may be displayed to the user in images on a single screen without overlap, comparing and contrasting differences for the education of the user (Col 5, lines 23-37). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a system and method of instruction for a sport improvement activity as disclosed by Mengoli/Ishida with display methods for improvement to the user in images on a single screen without overlap as taught by Studor for the purposes of a side-by-side comparison of the user against the instructor to assist the user in visualizing the motion needed for correction.

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Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L Sotomayor whose telephone number is 703-305-4558.

The examiner can normally be reached on 6:30-4:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jls
March 18, 2004


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